

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YEH-HUNG LAI, SURESH SUNDERRAJAN,
THADDEUS S. GULA, WILLIAM A. MRUK,
NARASIMHARAO DONTULA, GARY D. SMITH
and YUANQIAO RAO

Appeal 2006-2835
Application 10/033,496
Technology Center 1700

Decided: August 31, 2006

Before GARRIS, WARREN, and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL AND OPINION

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the grounds of rejection of appealed claims 2 through 8 and 18 through 21, all of the claims in the application, under 35 U.S.C. § 102(e) (2002) as being anticipated by Dontula '976 and by Dontula '656 (Answer 3-6).

Claim 18 illustrates Appellants' invention of an imaging member, and is representative of the claims on appeal:

18. An imaging member comprising an imaging layer and a base wherein said base comprises a thermoplastic polymer closed cell foam core sheet, wherein said foam core sheet has a topside and a bottom side, wherein said topside of said foam core sheet is adhered to an upper sheet, and said bottom side of said foam core sheet is adhered to a lower sheet, wherein said foam core sheet has a modulus of between 100 and 2758 MPa and a tensile toughness between 0.344 and 35 MPa, and wherein each of said upper and lower sheets has a modulus of between 1380 and 20000 MPa and a toughness between 1.4 and 210 MPa wherein each of said upper and lower sheets is selected from at least one member of the group consisting of paper, polyolefins, and polystyrene.

The references relied on by the Examiner are:

Dontula (Dontula '976)	US 6,447,976 B1	Sep. 10, 2002
Dontula (Dontula '656)	US 6,537,656 B1	Mar. 25, 2003

We refer to the Answer and to the Brief and Reply Brief for a complete exposition of the positions advanced by the Examiner and Appellants.

OPINION

The grounds of rejection based on the Dontula references are essentially the same, and thus we, like the Examiner (Answer 6-8) and Appellants (Br. 9-10), focus on the ground of rejection based on Dontula '976 as representative of the grounds of rejection.

It is well settled that the Examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of

ordinary skill in the art in possession thereof. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). All that is required to establish anticipation of a product claim is the disclosure in a reference of a single embodiment falling within the claim. *See e.g., Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985); *In re Gosteli*, 872 F.2d 1008, 1010, 10 USPQ2d 1614, 1616 (Fed. Cir. 1989).

The Examiner can reach the conclusion that, *prima facie*, an imaging member product embodiment disclosed in Dontula '976 falls within appealed claim 18 even though the reference is silent with respect to the claim limitations with respect to toughness, by pointing to evidence in the record establishing that it *reasonably appears* that an embodiment of the reference is identical to the claimed imaging members encompassed by the appealed claim. If the Examiner so establishes a *prima facie* case of anticipation, the burden shifts to Appellants to submit effective argument and/or objective evidence to patentably distinguish the claimed imaging members over the reference. *See generally, Spada*, 911 F.2d at 708-09, 15 USPQ2d at 1657-58 ("The Board held that the compositions claimed by Spada 'appear to be identical' to those described by Smith. While Spada criticizes the usage of the word 'appear,' we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition."); *In re Best*, 562 F.2d 1252, 1254-56, 195 USPQ 430, 432-34 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or

substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludtke*, [441 F.2d 660, 169 USPQ 563 (CCPA 1971)]. Whether the rejection is based on “inherency” under 35 USC § 102, on “prima facie obviousness” under 35 USC§ 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. [Footnote and citation omitted.]”); *In re Skoner*, 517 F.2d 947, 950-51, 186 USPQ 80, 82-83 (CCPA 1975) (“Appellants have chosen to describe their invention in terms of certain physical characteristics Merely choosing to describe their invention in this manner does not render patentable their method which is clearly obvious in view of [the reference]. [Citation omitted.]”).

The Examiner does not identify a specific imaging member embodiment disclosed by Dontula ‘976 that reasonably appears to fall within appealed claim 18 because of the specific materials in that product and the specific properties thereof. Instead, the Examiner points to Dontula ‘976 generic claim 1 and certain dependent claims, taking the position that these patent claims “disclose all the features of instantly claimed invention . . . except the modulus and toughness properties of each layer” (Answer 3). The Examiner states that the modulus ranges for the polymer closed cell foam core sheet and polymer top and bottom sheets of the base component disclosed by Dontula ‘976 at col. 6, ll. 23-29, “reads on the modulus of each layers of instant invention as claimed” (Answer 3).

The Examiner further states that

[a]s to the toughness, it is noted that Dontula '976 does expressly teach that the upper and lower sheets are chosen to satisfy specific requirements of properties, such as flexural modulus, etc. In particular, a toughness related problem with the element in cutting, punching, slitting, and chopping during transport through a photofinishing equipment is solved (column 5, lines 45-64).
[Answer 3-4; original emphasis deleted.]

Thus, the Examiner concludes that

Dontula '976 does teach exactly the same subject matter (an imaging member of the same laminate structure and comprising exactly the same polymers), made by exactly the same process (coextrusion, quenching, orienting, heat setting and laminating), and having the same toughness related required properties for application processing (i.e., having suitable cutting, slitting and chopping properties to be processed through a photofinishing equipment) as the instant invention . . . [and] although Dontula '976 is silent about the toughness data, a suitable toughness of each layer is also clearly anticipated by Dontula '976, because the imaging member meets the same toughness related required properties for processing through a photofinishing equipment.

[Answer 4.]

Appellants submit that Dontula '976 is not anticipatory because it does not describe "toughness" for the sheets in the base component, arguing that this property "is dependent upon issues such as chemical structure, crosslinking, and the amount and direction of orientation of the polymer sheet," and "not directly dependent upon modulus and . . . may differ substantially among materials with a similar modulus" (Br. 5). Appellants argue that "[t]oughness and modulus are distinct properties," explaining the difference (*id.* 6-7). In response, the Examiner admits that "there is no constant correlation between toughness and modulus" but maintains the

grounds of rejection because “nowhere does Dontula ‘976 teach an imaging element which differs from the instant invention in structure, composition, crosslinking, and the amount and direction of orientation of the polymer sheet . . . [and] the imaging member of Dontula does meet the same toughness-related required properties” required for processing through the same photofinishing equipment (Answer 6-7). In reply, Appellants submit that “[t]he property important for passing through a photofinishing machine . . . is stiffness not toughness” and the latter property is not recognized by Dontula ‘976 at col. 5, ll. 61-64 (Reply Br. 1-2).

We find that Dontula ‘976 claim 1 encompasses imaging members having components with the same basic elements specified in appealed claim 18, except that patent claim 1 requires that the closed cell foam core sheet and the upper and lower “flange” sheets, that is, upper and lower sheets, of the base are generically “polymers” while appealed claim 18 specifies that the closed cell foam core sheet is “a thermoplastic polymer” and the upper and lower sheets are “selected from at least one member of the group consisting of paper, polyolefins, and polystyrene.” Dontula ‘976 dependent claims 9 and 24 specify that the upper and lower sheets “comprise biaxially oriented polyolefin sheets,” and “comprise at least one member selected from the group consisting of high density polyethylene, polypropylene, or polystyrene; their blends or their copolymers,” respectively. No patent claim requires specific “polymer” materials for the closed cell foam core sheet of patent claim 1.

We find that, as the Examiner points out, none of the Dontula ‘976 claims specify the modulus or toughness properties of the closed cell foam

core sheet and the upper and lower sheets. Indeed, the only structural property specified in patent claim 1 is “said imaging member has a stiffness of between 50 and 250 millinewtons.” We further find that the modulus ranges disclosed in Dontula ‘976 at col. 6, ll. 23-29, relied on by the Examiner, in fact clearly overlap the claimed modulus ranges encompassed by appealed claim 18. We find that the “flexural modulus” and other disclosure in Dontula ‘976 at col. 5, ll. 45-64, relied on by the Examiner, in fact involve only the upper and lower sheets. However, the reference further discloses “a relationship between stiffness of the imaging element and the caliper and modulus of the foam core and the modulus of the flange sheets” (col. 5, l. 65, to col. 6, l. 21). The Dontula ‘976 Examples 4 through 7 illustrate base components in which a foamed polypropylene core sheet is laminated with upper and lower oriented polystyrene sheets having a “flexural modulus” range falling within the claimed modulus range in appealed claim 18 for upper and lower sheets which can be “polystyrene.”

On this record, we agree with Appellants. As a matter of fact, the imaging layers encompassed by Dontula ‘976 generic patent claim 1 and the claims dependent thereon relied on by the Examiner are not coterminous with or entirely fall within any or all of appealed claims 2 through 8 and 18 through 21 in all respects except for a description of the property of toughness. Indeed, the closed cell foam core sheets can be of any polymeric material and are not limited with respect to the property of modulus and thus, would not be limited with respect to the property of toughness. Therefore, on this basis alone, the patent claims of Dontula ‘976 do not reasonably appear to provide an identical description of the claimed imaging

element encompassed by the appeal claims to one skilled in this art within the meaning of § 102(e) even if the patent claims include within their scope subject matter which satisfy the claim limitations.

In this latter respect, it is well settled that a generic claim or disclosure does not provide an anticipatory description of any particular embodiment encompassed thereby. A determination that a generic disclosure encompasses embodiments that are identical or substantially identical to embodiments encompassed by claim, of course, raises issues with respect to whether the claimed invention would thus have been *prima facie* obvious to one of ordinary skill in this art within the meaning of 35 U.S.C. § 103(a). *See generally, Best*, 562 F.2d at 1254-56, 195 USPQ at 433-34; *Skoner*, 517 F.2d at, 950-51, 186 USPQ at 82-83.

Even assuming, arguendo, that the Examiner has established a *prima facie* case of anticipation over an embodiment disclosed by Dontula '976, such as the Dontula '976 Examples that we discussed above, Appellants' arguments in rebuttal with respect to the difference between the properties of modulus and toughness and the difference between the properties of toughness and stiffness has shifted the burden to the Examiner to again establish a *prima facie* case of anticipation in order to maintain the rejection. *See generally, Spada*, 911 F.2d at 707 n.3, 15 USPQ2d at 1657 n.3. The Examiner has not carried this burden. Indeed, the Examiner admits that there is no correlation between toughness and modulus properties, and has not addressed Appellants' position that there is no correlation between toughness and stiffness properties.

Appeal 2006-2835
Application 10/033,496

Our considerations with respect to the ground of rejection over Dontula '656 result in the same analysis.

Accordingly, in the absence of a *prima facie* case of anticipation, we reverse the grounds of rejection under Dontula '976 and '656 under 35 U.S.C. § 102(e).

The examiner's decision is reversed.

REVERSED

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